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John L. Rogitz
Rogitz & Associates
750 B. Street, Suite 3120
San Diego, CA 92101

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/829,249
Filing Date: April 09, 2001
Appellant(s): DUNCAN ET AL.

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/23/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-5 and 7-20.

Claims 6 and 21-31 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The amendment after final rejection, as filed on 4/23/2004, and which cancels claims 21-31, has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The issues, as adjusted, are as follows:

(a) Whether Claims 1-5 and 7-12 are unpatentable under 35 U.S.C. §103 as being obvious over Oberteuffer et al. (U.S. Patent No. 6,438,523) in view of Kono (U.S. Patent No. 5,914,707).

(b) Whether claims 13-20 are unpatentable under 35 U.S.C. §103 as being obvious over Oberteuffer et al. in view of Kono.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-5 and 7-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,438,523	Oberteuffer et al.	8-2002
5,914,707	Kono	6-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 1/28/2004.

(11) Response to Argument

Regarding claim 1, the appellant argues that the specific correspondence between plural input modes and plural output modes, as expressed in claim 1, cannot be anticipated by the combined teachings of Oberteuffer et al. (hereafter referred to as "Oberteuffer") and Kono, since neither reference teaches implementing multiple input modes *and* multiple output modes. The appellant thus appears to suggest that, for claim 1 to be anticipated, a single reference must teach implementing multiple input modes and multiple output modes, as the appellant asks,

> Since Oberteuffer et al. does not envision multiple output modes, and Kono does not envision multiple input modes, how can plural input-output correspondences be suggested by either? (See page 3, lines 14-15 of the appeal brief).

In response to such a piecemeal analysis of the references, the Examiner notes that claim 1 was not rejected by *either* Oberteuffer or Kono, but instead was rejected by the combined teachings of Oberteuffer and Kono. While it is true that neither Oberteuffer nor Kono explicitly presents a device with multiple input and multiple output modes, the Examiner nevertheless maintains that Oberteuffer and Kono, when combined, teach outputting content graphically in response to graphical input, and outputting content audibly in response to audio input. Without question, Oberteuffer demonstrates outputting content graphically in response to graphical input (for

example, see column 4, lines 37-53). Thus the main issue regarding the patentability of claim 1 is whether or not Oberteuffer and Kono teach outputting audio content in response to audio input, and whether Oberteuffer and Kono may be combined to teach such a feature. The Examiner believes so, as Oberteuffer explicitly teaches audio input, and Kono teaches outputting audio content in response to such input. For example, Oberteuffer demonstrates inputting commands via speech (see column 4, lines 54-61). Kono teaches responding to commands by outputting content comprising audio (for example, see column 3, line 55 – column 4, line 35; and column 7, lines 28-32). Thus contrary to the appellant's assertion that "[t]he proposed combination [of Oberteuffer and Kono] would merely result in allowing a user to input data using voice or handwriting...and then have the data played backed simultaneously aurally and on screen..." (see page 3, line 19 – page 4, line 2 of the appeal brief), the Examiner maintains that the proposed combination further teaches responding to graphical user input with content comprising graphical content, and responding to audio user input with content comprising audio content.

Further concerning claim 1, the appellant asserts that, although Kono describes a pocket organizer which can be used as a dictaphone, Kono does not teach a particular correspondence between particular input modes and respective output modes. The Examiner agrees, for if Kono did teach a particular correspondence between particular input modes and output modes, the Kono reference by itself would be enough to anticipate claim 1. Rather, the submission that Kono discloses a device which may receive speech input provides further evidence of the similarity between the Kono device and the Oberteuffer device, which receives speech input in

the form of text and commands (for example, see column 4, lines 27-62 of Oberteuffer). Such a similarity serves to support any motivation to combine Oberteuffer and Kono.

As per motivation, the appellant asserts that the proffered suggestion to combine Oberteuffer and Kono, that "audio output further enhances understanding of graphically displayed content," bears no relevance to Oberteuffer, which displays no book content at all. The appellant particularly submits,

> ...[A]ll Oberteuffer et al. does is accept voice input and handwriting input for digitizing them into computer files, something that nothing in the prior art, particularly Oberteuffer et al., suggests must be improved by providing multi-mode output. In other words, the user of Oberteuffer et al. does not seek to access content from anything, but rather to input content already known to the user into a computer file, thus requiring no multi-mode repetitive output of what the user has just input. (See page 4, lines 14-18 of appellant's appeal brief).

In response the Examiner notes that, even assuming the device of Oberteuffer is unable to display book content (an idea with which the Examiner does not necessarily agree), the device of Oberteuffer still necessarily displays data, such as text data. For example, Oberteuffer discloses that the user may create documents of various types by entering text and commands via speech and handwriting (for example, see column 4, lines 17-62). It is well understood that the device of Oberteuffer has the additional capability of storing and displaying such documents, for the documents would be of no use if they could not be accessed and viewed. Along the lines of such functionality, Kono describes a similar type of device:

> ...[A] compact microcomputer notebook or pocket organizer is useful to collect dictated communications, such as, notes relative to an overseas trip and the user may visually read written words or sentences that appear on the organizer's display, but for such a small slim device there is no facility to orally reproduce the voice pronunciation of the words and sentences due to its compactness. To include concurrent audio reproduction capability and user inquirable and inquisitorial interfacing while retaining

> their compact size is considered not practical under present technology for such organizers. (See column 1, lines 42-52).

Kono teaches improving these devices by providing audio output in synchronization with other data, and interfacing to allow random access to this audio and other data:

> ...[T]he employment of an optical medium relative to this invention renders it possible to display a large amount of data in the form of alphanumerics, simple diagram and animation graphics and to reproduce audio data, such as sound, voice and music, being synchronized in presentation with the displayed data. The present invention provides a simple, compact and portable electronic apparatus for recording visual and audio data, randomly retrieving such data from the optical memory and synchronizing the displayed data with the audio reproduced data. (See column 4, lines 21-32).

Thus, contrary to the appellant's assertion that nothing in the prior art suggests that Oberteuffer must be improved by providing multi-mode output, Kono describes a similar type of device, and suggests it may be improved by providing multi-mode output in the form of synchronized graphical and audio data. Such teachings are certainly relevant to the device of Oberteuffer, which like the prior art device described by Kono, has the functionality of collecting dictated communications and visually displaying written words on a display. The proffered suggestion to combine Oberteuffer and Kono is consequently considered to bear relevance to Oberteuffer.

Further regarding the Examiner's rejection for claim 1, particularly regarding whether the device of Oberteuffer is able to display content other than what the user enters into it, the appellant alleges that although the device comprises a web browser, such a web browser is only used to create, edit and view documents. The appellant thus concludes that one would not have been motivated to combine Oberteuffer with Kono, which concerns displaying data other than what the user enters into it. Even assuming the device of Oberteuffer is unable to display content other than what the user enters into it (an idea with which the Examiner does not necessarily

agree), the teachings of Kono are still applicable to Oberteuffer, since as described in the previous paragraph, Kono teaches providing a multi-mode output with a device that explicitly displays content that the user puts into it. The Examiner maintains, additionally, that the web browser of Oberteuffer is able to download content, particularly content not created by the user. Such functionality is well-known in the art, and certainly more well-known than the appellant's alleged use of a web browser to create and edit documents.

In reference to claim 13, the appellant argues that neither Kono nor Oberteuffer suggest maintaining a current position in content and/or a spanning region of the content being rendered such that first and second output threads are run simultaneously with each other, and whereby as recited in claim 13, an abstract interface determines positions at which tangible interfaces should pause when required to coordinate the multiple output modes. The appellant particularly attacks the Examiner's interpretation of the Kono reference, stating that the Examiner's allegation that Kono teaches pausing audio or video output is incorrect. As evidence, the appellant submits that Kono discloses that audio output can footnote or exemplify displayed text, citing col. 7, lines 30-33 of Kono, and concludes that "[t]his does no implicate the need to pause anything because the content of the audio footnote, while related to the text, is not the same as the text and, hence, only a loose coupling such as starting both displays simultaneously need be implemented." (See page 6, line 15 – page 7, line 3 of the appellant's appeal brief). While it is true that Kono describes audio output which can exemplify displayed text, the Examiner maintains that either the display of the text, or the output of the audio, is paused in order to synchronize the text and audio. For example, Kono discloses that when an audio passage serves as a footnote, it is within

the context of an electronic book comprising a multitude of pages (see column 6, line 66 – column 7, line 39). An audio passage is associated with a particular page, and played when an icon corresponding to the audio passage is selected (see column 7, lines 28-32). By having the audio and text of an electronic book divided into such pages, the audio and text are synchronized; the display of an electronic book is paused on a single page, and the audio passage directly associated with that page is played. Likewise, if an audio passage associated with a particular page is being played, and the user advances to a new page, it is understood that the audio passage would be paused, as it is no longer associated with the new page. The positions at which the audio and graphical interfaces should pause in order to coordinate the multiple output modes are thus determined, each position specifically corresponding to a page of the electronic book.

Further regarding claim 13, the appellant argues that there is no teaching or suggestion by Kono or Oberteuffer that user input commands can be received from an audio user interface, whereby a graphical user interface is updated in response thereto, and vice-versa. The appellant, however, fails to provide any support regarding such an argument, other than stating that "[t]he Office Action indulges in some pretty creative bending of the references to conjure up this part of claim 13." The appellant fails to specifically address the Examiner's evidence, as presented in the Office Action of 1/28/2004, and which is repeated as follows:

> In regard to claim 13, the processor of the above-described electronic book of Oberteuffer and Kono is considered an "abstract interface," like that of the claimed invention, wherein this processor is responsible for accessing content stored in the data storage of the electronic book as is known in the art. In addition, Oberteuffer discloses that the electronic book may receive commands via its audio user interface, whereby it updates its graphical user interface in response thereto (for example, see column 5, lines 57-65). Kono similarly teaches that the electronic book may receive commands

> via its graphical user interface, whereby it updates its audio user interface in response thereto. Specifically, it is understood that commands to change a graphically displayed page of a document may be entered via the graphical user interface, whereby the speech interface is updated in order to reflect the currently displayed page (see column 7, lines 29-39). It is therefore understood that the above-described electronic book taught by Oberteuffer and Kono comprises: content stored in a data storage; an abstract interface accessing the data storage; an audio user interface communicating with the abstract interface; and a graphics user interface communicating with the abstract interface, the abstract interface receiving user input commands from the audio user interface and updating the graphics user interface in response thereto, the abstract user interface receiving user input commands from the graphics user interface and updating the audio user interface in response thereto. (See page 8, lines 5-21).

In light of such support, the Examiner maintains that the combination of Oberteuffer and Kono teaches receiving user input commands from an audio user interface, whereby a graphical user interface is updated in response thereto, and vice-versa.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Blaine Basom
Assistant Patent Examiner
August 5, 2004

Conferees:

RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173

Raymond J. Bayerl
Primary Patent Examiner

JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

John W. Cabeca
Supervisory Patent Examiner

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

Joseph H. Feild
Supervisory Patent Examiner

John L. Rogitz
Rogitz & Associates
750 B. Street, Suite 3120
San Diego, CA 92101